

## APPLICANT'S REMARKS

### 1. Status of the Claims

Claims 1–13 and 19 are pending as currently amended. Claims 14–18 are canceled.

### 2. Rejection of the Claims under 35 U.S.C. 112

The claims are rejected under 35 U.S.C. 112 for various reasons. The Applicant respectfully submits that, in light of the foregoing amendments to the claims, the §112 rejections to the claims are overcome and should be withdrawn.

### 2. Rejection of the Claims under 35 U.S.C. 101

Claims 16–18 are rejected under 35 U.S.C. 101. The Applicant respectfully submits that, in light of the foregoing amendments to the claims, the §101 rejection of claims 16–18 is moot and should be withdrawn.

### 3. Rejection of the Claims under 35 U.S.C. 102(e) based on GIELEN

The claims are rejected under 35 U.S.C. 102(e) based on PCT International Application Publication No. WO 2004/024700 (GIELEN '700). The Examiner asserts that "the instant claims read on reference disclosed compounds, see structural formula (I) in page 3 and the corresponding compounds of the examples."

The Applicant respectfully disagrees with the Examiner and submits that the claims of this application are not anticipated by GIELEN '700.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly

or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that GIELEN '700 does not disclose or even suggest the presently claimed definition of R<sup>4</sup>. In other words, R<sup>4</sup> as claimed in this application does not overlap R<sup>4</sup> as disclosed in GIELEN '700.

For at least this reason, the Applicant respectfully requests that the §102(e) rejection of the claims based on GIELEN '700 be reconsidered and withdrawn.

4. Provisional Double Patenting Rejection

The Applicant acknowledges the provisional rejection on the ground of non-statutory double-patenting based on U.S. Pat. App. Nos. 10/590,786 and 10/527,391 (which corresponds to GIELEN '700). At such time as this provisional rejection becomes an actual double patenting rejection, the Applicant will overcome the actual double patenting rejection or file a terminal disclaimer.

5. Conclusion

The Applicant respectfully requests favorable consideration of this Amendment.

Respectfully submitted,

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